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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,267	12/03/2001	Emil C. Gotschlich	040853-01-5029-02	8278
28977	7590	02/18/2004	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP 1701 MARKET STREET PHILADELPHIA, PA 19103-2921			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER

1652

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application N .</b> 10/007,267	<b>Applicant(s)</b> GOTSCHLICH, EMIL C.	
	<b>Examiner</b> Manjunath N. Rao, Ph.D.	<b>Art Unit</b> 1652	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 34-39 and 50-57.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 58.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

--26-04

***Response to After-final amendment***

Applicant's response to the final rejection of 11-5-03, filed on 1-26-04 has been considered and entered. However, such amendments and arguments are still no persuasive to overcome the previous rejection of claim 58 under Double patenting rejection.

Claim 58 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No.5705367. As explained in the previous Office action an obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim, because the examined claim is either anticipated by, or would have been obvious over the reference claim. See, e.g., *In re Berg*, 140 F.3d 1428,46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi* 759 F.2d 887,225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 58 of the instant application and claim 2 (specifically part d) of the reference patent are both directed to a method of making oligosaccharide having the structure  $\text{GalNAc}\beta 1 \rightarrow 3\text{Gal}\beta 1 \rightarrow 4\text{GlcNAc}\beta 1 \rightarrow 3\text{Gal}\beta 1 \rightarrow 4\text{Glc}$ , said method comprising contacting a reaction mixture comprising an activated GalNAc to an acceptor moiety comprising  $\text{Gal}\beta 1 \rightarrow 4\text{GlcNAc}\beta 1 \rightarrow 3\text{Gal}\beta 1 \rightarrow 4\text{Glc}$  residue in the presence of a glycosyltransferase with amino acid sequence SEQ ID NO:5 which is identical to the claim 2(d). The portion of the specification (and the claims) in the reference patent that supports the recited method using the amino acid sequence SEQ ID NO:5 would anticipate the method claimed in claim 58 herein using the polypeptide of claim 37 which is SEQ ID NO:5. Claim 58 of the

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instant application listed above cannot be considered patentably distinct over claim 2 of the reference patent, even though it involves steps not recited in claim 58 of the instant application, when there is specifically recited embodiment that would anticipate mainly claim 58 of the instant application. Alternatively, claim 58 cannot be considered patentably distinct over claim 2 of the reference patent when there is specifically disclosed embodiment in the reference patent that supports claim 2 (specifically part d) of that patent and falls within the scope of claim 58 herein because it would have been obvious to one having ordinary skill in the art to modify claim 2 of the reference by selecting a specifically disclosed embodiment that supports that claim. i.e., a method of making oligosaccharide having the structure  $\text{GalNAc}\beta 1 \rightarrow 3\text{Gal}\beta 1 \rightarrow 4\text{GlcNAc}\beta 1 \rightarrow 3\text{Gal}\beta 1 \rightarrow 4\text{Glc}$ , said method comprising contacting a reaction mixture comprising an activated GalNAc to an acceptor moiety comprising  $\text{Gal}\beta 1 \rightarrow 4\text{GlcNAc}\beta 1 \rightarrow 3\text{Gal}\beta 1 \rightarrow 4\text{Glc}$  residue in the presence of a glycosyltransferase with amino acid sequence SEQ ID NO:5. One of ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being one of the preferred embodiment within claim 2 of the reference patent.

In their response applicants argue that the above Double patenting rejection is improper because Examiner is considering a part of the claim and not the whole claim in the reference and that the claim in the reference involves sequential steps. Such an argument is not found to be persuasive to overcome the above rejection because of the reasons provided above. Applicants have recited the decisions handed down by the courts with reference to other similar cases. However, Examiner does not have the list of claims or the claim language of those cases and therefore cannot concur with the applicants. Therefore the above rejection is maintained.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
MANJUNATH RAO  
PATENT EXAMINER  
Manjunath N. Rao  
February 10, 2004